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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
SUBRAMANIAN, NARAYANSWAMY	
ART UNIT	**PAPER NUMBER**
3624	

DATE MAILED: 05/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/609,228	FORLAI, LUIGI	
	Examiner	Art Unit	
	Narayanswamy Subramanian	3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 January 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *2,6,17,20-33,47 and 48* is/are pending in the application.

4a) Of the above claim(s) *17,20-25,28,31,47 and 48* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *2,6,26,27,29,30,32 and 33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This office action is in response to applicants' communication filed on January 20, 2006. Amendments to claims 2, 6 and 33 and addition of claims 47-48 have been entered. Claims 2, 6, 17, 20-33 and 47-48 are pending in the application. New claims 47-48 are withdrawn from consideration as being drawn to a non-elected species as discussed below. Claims 2, 6, 26, 27, 29, 30, 32 and 33 have been examined. The response to amendment, rejections and response to arguments are stated below.

Response to Amendment

2. Newly submitted claims 47-48 are directed to a different species of the generic feature of randomly displaying an offer, where claim 6 is generic. In a previous office action the applicant elected the specie corresponding to claims 26, 27, 29 and 30. The elected species were examined in the last office action.

3. Since applicant has received an action on the merits for the originally elected species, this specie has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 47-48 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03. Upon the allowance of a generic claim applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1. 141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP 809.02(a).

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claim 2 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application

No.09/609,142. Although the conflicting claims are not identical, they are not patentably distinct from each other because they recite essentially the same features of facilitating a transaction between a buyer and a seller using an electronic network system.

Claim 1 of '142 recites all the features of claim 2 of the instant invention except the step of inputting a sale offer parameter. The step of inputting a sale offer parameter is old and well known to one of ordinary skill in the auction art. This step allows a seller to define the terms of his/her offer. Hence it would have been obvious to one of ordinary skill in the art to include this feature to claim 1 of '142.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 2, 6, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Odom et al (US Patent 6,058,379).

Claim 2, Odom teaches a method for using an electronic network system to facilitate a transaction between a seller and a buyer, said method comprising the steps of: inputting a sale offer parameter for randomly generating at least one sale offer to purchase a product or service (See Odom Column 3 lines 20-26); randomly displaying, through the electronic network system, the at least one sale offer to a selected buyer at an

unexpected period of time (See Odom Column 3 lines 20-26 and Column 5 lines 46-50); and withdrawing the display of the randomly generated sale offer in response to an absence of an indication of acceptance of the randomly generated sale offer by the buyer within a predetermined period of time after the step of displaying the randomly generated sale offer (See Odom Column 5 lines 33-38, Column 6 lines 59-63, Column 8 lines 21-23, lines 25-26 and Column 9 lines 65-67). Posting information on the Web and sending e-mail to notify implies displaying at an unexpected period of time.

Odom does not explicitly teach the step where an offer price is substantially equal to a delivery price associated with the transaction, the delivery price being less than a current value of the offered product or service in a competitive marketplace.

Official notice is taken that the step where an offer price is substantially equal to a delivery price associated with the transaction, the delivery price being less than a current value of the offered product or service in a competitive marketplace is old and well known. For instance when companies like Dell Computers offer their products on sale over the Internet they also offer free delivery of the product. The sale price is below the normal retail price of the product and with free delivery the offer price is less than a current value of the offered product in a competitive marketplace. Such offer prices are an incentive for the customers to purchase the products during the time when the promotion is on.

It would have been obvious to one of ordinary skill in the art at the time of invention to modify Odom to include these steps. The combination of disclosures suggests that buyers would have benefited from price incentives offered by the seller.

Claim 6, Odom teaches a method of making a sale offer from a seller to at least one buyer visiting a Internet web site, comprising the steps of: displaying, on the web site, a sale offer to purchase a product or service to the at least one selected buyer at a random point in time unknown to the buyer (See Odom Column 3 lines 20-26 and Column 5 lines 46-50); and withdrawing the displayed sale offer from the Internet website when the at least one buyer does not indicate acceptance of the sale offer within a predetermined period of time (See Odom Column 5 lines 33-38, Column 6 lines 59-63, Column 8 lines 21-23, lines 25-26 and Column 9 lines 65-67). Posting information on the Web and sending e-mail to notify implies displaying at a random point in time unknown to the buyer.

Odom does not explicitly teach the step where an offer price is substantially equal to zero.

Official notice is taken that the step where an offer price is substantially equal to zero is old and well known. For instance companies that are about to liquidate their inventories offer prices that are substantially equal to zero in order to liquidate their inventories quickly. Merchants also announce offers of some products for free (for a limited time while quantities last) to attract customers to their store (where customers usually land up purchasing other goods at regular prices). Such offer prices are an incentive for the customers to purchase the products during the time when the promotion is on.

It would have been obvious to one of ordinary skill in the art at the time of invention to modify Odom to include this step. The combination of disclosures suggests that buyers are benefited from price incentives offered by the seller.

Claim 27, Odom teaches the step wherein the step of randomly displaying includes displaying the at least one sale offer to the selected buyer over a predetermined period of time determined by the seller and unknown to the selected buyer (See Odom Column 5 lines 34-38, seller intervention implies the ability of the seller to display one sale offer to the selected buyer over a predetermined period of time determined by the seller and unknown to the selected buyer).

8. Claims 26, 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Odom et al (US Patent 6,058,379) in view of Smith (US Patent 6,502,076 B1).

Claims 26, 29 and 30, Odom teaches methods of claim 2 and 6 as discussed above including the step of randomly displaying includes displaying the at least one sale offer to the selected buyer over a predetermined period of time determined by the seller and unknown to the selected buyer (See Odom Column 5 lines 34-38, seller intervention implies the ability of the seller to display one sale offer to the selected buyer over a predetermined period of time determined by the seller and unknown to the selected buyer).

Odom does not explicitly teach the step of providing a random frequency device for displaying the at least one sale offer in an unpredictable manner.

Smith teaches the step of providing a random frequency device for displaying the at least one sale offer in an unpredictable manner (See Smith Column 6 lines 46-54 and Column 17 lines 17-20).

Both Smith and Odom are concerned with the problem of providing information to buyers to facilitate selling of goods and services. It would have been obvious to one of ordinary skill in the art at the time of invention to modify Odom to include the teachings

of Smith. The combination of disclosures suggests that sellers would have benefited from being able to target different buyers by randomly varying the times when products are offered.

9. Claims 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Odom et al (US Patent 6,058,379) in view of Conklin et al (US Patent 6,141,653).

Claim 32, Odom teaches a method of claim 2 as discussed above including a first indication of acceptance from the buyer in response to the random display of the at least one sale offer (See Column 6 lines 27-33), negotiation between the seller and the buyer (See Odom Column 6 lines 11-19) and clearing the transaction (Column 3 lines 43-46 and Column 7 lines 56-60) and requesting delivery of the offered product or service to the buyer (inherent in the disclosure of Odom).

Odom does not explicitly teach the steps of displaying at least one term associated with the at least one randomly generated sale offer in response to the first indication of acceptance; receiving a second indication of acceptance from the buyer in response to the display of the at least one term associated with the at least one randomly generated sale offer; displaying an acceptance form to the buyer in response to the second indication of acceptance from the buyer; receiving a third indication of acceptance from the buyer in response to the display of the acceptance form for forming a purchase agreement concerning the offered product or service; displaying at least one payment method option in response to the third indication of acceptance; receiving at least one payment method selection from the buyer in response to the display of the at least one payment method option; and transferring a sum corresponding to the selected payment method from the buyer to the seller.

Conklin teaches the steps of iteratively negotiating multiple variables, documenting the transaction, providing payment options and transferring the payment amount online (See Conklin Column 14 lines 3-31 an lines 63-65). These steps are common in trading between two parties to a transaction. The disclosure of Conklin is interpreted to include the features of displaying at least one term associated with the at least one randomly generated sale offer in response to the first indication of acceptance; receiving a second indication of acceptance from the buyer in response to the display of the at least one term associated with the at least one randomly generated sale offer; displaying an acceptance form to the buyer in response to the second indication of acceptance from the buyer; receiving a third indication of acceptance from the buyer in response to the display of the acceptance form for forming a purchase agreement concerning the offered product or service; displaying at least one payment method option in response to the third indication of acceptance; receiving at least one payment method selection from the buyer in response to the display of the at least one payment method option; and transferring a sum corresponding to the selected payment method from the buyer to the seller.

Both Conklin and Odom are concerned with the problem of facilitating transaction between buyers and sellers of goods and services. It would have been obvious to one of ordinary skill in the art at the time of invention to modify Odom to include the teachings of Conklin. The combination of disclosures suggests that both parties to the transaction would have benefited from the smooth negotiations and conclusion of the transactions provided by the disclosures.

Claim 33, Odom teaches a method for using an electronic network system to facilitate a transaction between a seller and a buyer said method comprising the steps of: inputting a sale offer parameter for randomly generating at least one sale offer to purchase a product or service (See Odom Column 3 lines 20-26); randomly displaying, through the electronic network system, the at least one sale offer to a selected buyer at an unexpected period of time (See Odom Column 3 lines 20-26 and Column 5 lines 46-50); withdrawing the display of the randomly generated sale offer in response to an absence of an indication of acceptance of the randomly generated sale offer by the buyer within a predetermined period of time after the step of displaying the randomly generated sale offer (See Odom Column 5 lines 33-38, Column 6 lines 59-63, Column 8 lines 21-23, lines 25-26 and Column 9 lines 65-67, posting information on the Web and sending e-mail to notify implies displaying at an unexpected period of time); receiving, through the electronic network system, a first indication of acceptance from the buyer in response to the random display of the at least one sale offer (See Column 6 lines 27-33); and requesting delivery of the offered product or service to the buyer (inherent in the disclosure of Odom also see discussion of claim 2 above).

Odom does not explicitly teach displaying at least one term associated with the at least one randomly generated sale offer in response to the first indication of acceptance; receiving a second indication of acceptance from the buyer in response to the display of the at least one term associated with the at least one randomly generated sale offer; displaying an acceptance form to the buyer in response to the second indication of acceptance from the buyer; receiving a third indication of acceptance from the buyer in response to the display of the acceptance form for forming a purchase agreement

concerning the offered product or service; displaying at least one payment method option in response to the third indication of acceptance; receiving at least one payment method selection from the buyer in response to the display of the at least one payment method option; transferring a sum corresponding to the selected payment method from the buyer to the seller and wherein the at least one term associated with the randomly generated sale offer comprises an offer price substantially equal to a delivery price associated with sending the offered product or service to the buyer, the delivered price being substantially less than a current market value of the offered product or service in a competitive market.

Conklin teaches the steps of iteratively negotiating multiple variables, documenting the transaction, providing payment options and transferring the payment amount online (See Conklin Column 14 lines 3-31 an lines 63-65). These steps are common in trading between two parties to a transaction. The disclosure of Conklin is interpreted to include the features of displaying at least one term associated with the at least one randomly generated sale offer in response to the first indication of acceptance; receiving a second indication of acceptance from the buyer in response to the display of the at least one term associated with the at least one randomly generated sale offer; displaying an acceptance form to the buyer in response to the second indication of acceptance from the buyer; receiving a third indication of acceptance from the buyer in response to the display of the acceptance form for forming a purchase agreement concerning the offered product or service; displaying at least one payment method option in response to the third indication of acceptance; receiving at least one payment method selection from the buyer in response to the display of the at least one payment method

option; and transferring a sum corresponding to the selected payment method from the buyer to the seller.

Both Conklin and Odom are concerned with the problem of facilitating transaction between buyers and sellers of goods and services. It would have been obvious to one of ordinary skill in the art at the time of invention to modify Odom to include the teachings of Conklin. The combination of disclosures suggests that both parties to the transaction would have benefited from the smooth negotiations and conclusion of the transactions provided by the disclosures.

Odom does not explicitly teach the step wherein the at least one term associated with the randomly generated sale offer comprises an offer price substantially equal to a delivery price associated with sending the offered product or service to the buyer, the delivered price being substantially less than a current market value of the offered product or service in a competitive market.

Official notice is taken that the step where an offer price is substantially equal to a delivery price associated with the transaction, the delivery price being less than a current value of the offered product or service in a competitive marketplace is old and well known. For instance when companies like Dell Computers offer their products on sale over the Internet they also offer free delivery of the product. The sale price is below the normal retail price of the product and with free delivery the offer price is less than a current value of the offered product in a competitive marketplace. Such offer prices are an incentive for the customers to purchase the products during the time when the promotion is on.

It would have been obvious to one of ordinary skill in the art at the time of invention to modify Odom to include these steps. The combination of disclosures suggests that buyers would have benefited from price incentives offered by the seller.

Response to Arguments

10. Applicant's arguments with respect to pending claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (571) 272-6751. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are

unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (571) 272-6747. The fax number for Formal or Official faxes and Draft to the Patent Office is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PMR or Public PAIR. Status information for unpublished applications is available through Private PMR only. For more information about the PMR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dr. N. Subramanian NS
April 3, 2006

JAGDISH N. PATEL
PRIMARY EXAMINER